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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING
U. S. PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAURICE LORETTI, RAOUL CHATTOT, and
SAVKA DJOKIC

Appeal 2010-005585
Application 10/562,368
Technology Center 1700

Oral Hearing Held: April 13, 2011

Before CHARLES F. WARREN, JEFFREY T. SMITH, and
BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on Wednesday, April 13, 2011, commencing at 1:18 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Courville, a Notary Public.

PROCEEDINGS

THE USHER: Calendar No. 22, Appeal No. 2010-5585. Mr. Dao.

MR. DAO: Good afternoon.

JUDGE WARREN: Good afternoon, Mr. Dao.

MR. DAO: Good afternoon, Judge.

JUDGE WARREN: Judge Franklin is joining us from a remote location.

MR. DAO: Good afternoon.

JUDGE WARREN: Ms. Courville is our court reporter today and if you would please provide her with a business card or some other indicia of affiliation, we would appreciate it. Thank you.

As you know, sir, you have 20 minutes. You may begin when ready.

MR. DAO: Okay. If I may approach the panel? I prepared, just from printouts of the graphs from the patent applications in the prior art itself. Also, this helps to serve to summarize just the background of the application as well as the prior art. I think it helps with --

JUDGE WARREN: Is this from a reference?

MR. DAO: Yes. They're the cited reference. And just the front sheet is just put in picture form of what we argue in writing so that it helps to summarize as we proceed.

1 JUDGE WARREN: Okay. If you, when you talk about the parts of
2 the submission, if you would please identify the source so Judge Franklin
3 can access it?

4 MR. DAO: You bet. Yeah.

5 JUDGE WARREN: Thank you.

6 MR. DAO: The graphs in the back are all from the applications of
7 prior art. I will point out to you where they come from as we talk about
8 them.

9 JUDGE WARREN: Good. Okay. Fine.

10 MR. DAO: All right. So, if I may talk about the upper part of the
11 first page for a second, which is a summary of the instant application. And I
12 will also itemize or actually summarize and point out from our current
13 application where the support for that comes from.

14 In short, what you have in the instant application is you have a
15 multilayer film, and the purpose of the film really is to control the relative
16 humidity by controlling on the outer layers. If you look at the upper graph,
17 the upper chart, the outer layer, which is --

18 JUDGE WARREN: Where does this chart come from?

19 MR. DAO: Okay. So this is just a summary of the background. I
20 will point out to you, like, for example, paragraph 18 and paragraph 37 talks
21 about this first chart I'm about to --

22 JUDGE WARREN: And that's in your specification?

23 MR. DAO: That's correct. So in our specification paragraph 18 and
24 37.

25 In essence, what's happening, to control the oxygen --

26 JUDGE WARREN: We do not have paragraph numbers.

1 MR. DAO: Oh, in the spec there's no paragraph numbers? I have the
2 printout --

3 JUDGE WARREN: I think you're probably referring to the published
4 application.

5 MR. DAO: Yes, the published application.

6 JUDGE WARREN: We do not have the published application.

7 MR. DAO: Oh, I apologize. Because in the -- in my write-up in
8 preparation, I've identified by paragraph number.

9 JUDGE WARREN: Judge Franklin, do you have the published
10 application?

11 JUDGE FRANKLIN: I don't.

12 MR. DAO: If I may then supplement -- right now I'll just point to the
13 paragraph. If I can supplement it by pointing to the line and page number
14 from the application, would that work?

15 JUDGE WARREN: That's fine.

16 MR. DAO: Okay. So, controlling relative humidity is the key, and
17 what that does in the instant application it realizes, in paragraph 1, that at
18 ambient temperature, room temperature, all bags does a relatively great job
19 at reducing oxygen absorption through the layer as well as permeability of
20 the water solution outside to the environment. However, the real problem
21 occur is during steam autoclave. That's when the plastic gets melt; it's
22 heated and the pores open up and that's when you have a lot of water
23 absorption. And this is in the instant application paragraph 18, which I will
24 supplement the line numbers as we proceed.

25 So to control oxygen permeability through the layers, then, what this
26 application seeks to do is it realizes that relative humidity is the key. So

1 after autoclave, the goal is to use an outer layer to allow desorption, to allow
2 water to evaporate out the layer, and that's how you control the middle
3 oxygen permeability is to control the desorption, emissions of water that are
4 leaving the outer layer. And that is in paragraph 37 of the instant
5 application.

6 So, in short, just real basic is that --

7 JUDGE WARREN: Do you have a page number for that?

8 MR. DAO: I would have to supplement. I'm sorry.

9 JUDGE WARREN: Oh, you don't have it with you today?

10 MR. DAO: Yeah, I just have the paragraph numbering, so I would
11 need to supplement that. And if you can also assist me by pointing out how
12 I can supplement the support after the hearing, I will gladly do that by
13 tomorrow.

14 Okay. So, the prior art, however, in comparison, what the prior art
15 does is, for example -- one second -- Loretti, Loretti and Hogstrom, what it
16 does instead is that instead of allowing water to come in as well as
17 desorption, which is leaving the outer layer, it forms a barrier. It prevents
18 moisture from coming altogether. So if you look at the chart that's prepared,
19 so the goal of the other two prior art -- I don't know if you have a chance to
20 see this -- is forming a barrier to prevent the middle oxygen barrier layer
21 from getting moisture altogether. And it's cited in Loretti that -- and I will
22 point out to you the paragraph. Loretti -- in Hogstrom, column 3, line 32 to
23 39. Hogstrom, line 32 to 39, column 3.

24 What Hogstrom seeks to do is that it realizes in the EVOH middle
25 layer the layer is great at oxygen barrier only if it stays dry. So, therefore,
26 Hogstrom, as well as the other cited art, Loretti, the goal then is to form a

1 barrier to keep that layer dry. So what it does, it -- view it as a shield, a
2 shield to prevent the middle layer from getting moist or wet. Whereas, in
3 the instant application, it realizes that the key is actually relative humidity,
4 so it allows moisture to come in but allows high rate of desorption.

5 So if I may now, if you could switch the page to Figure 1 of the
6 instant application, I will point out to you the effect of what this application
7 does.

8 So Figure 1 of the instant application shows that A-1, which is the
9 film of the instant application, at 50% humidity it has a very low oxygen
10 permeability. It then compares that to a film layer A-2, also in Figure 1 of
11 the instant application, and it shows and describes, and I cite here -- this is
12 paragraph 37. So again I apologize. I will supplement --

13 JUDGE SMITH: Excuse me, counselor.

14 MR. DAO: Sure.

15 JUDGE SMITH: Can we move this discussion to focusing on the
16 claimed invention and the distinction between the cited references?

17 MR. DAO: Sure.

18 JUDGE SMITH: I mean, the overview -- we understand what your
19 invention is. I'd just like to focus on the claims.

20 MR. DAO: Sure, sure. Okay.

21 So then jumping then to claim -- the first rejection, which is in view of
22 Loretti under Section 102. So the essence of this rejection is that Loretti,
23 which teaches different films -- and in our Appeals Brief we provided a table
24 that shows that the layers are different, because the outer layer of the instant
25 application is PET; whereas, Loretti in the prior art shows polyamide, which
26 is PA.

1 So the claim recites properties of these multilayers with the outer
2 layers from the instant application in the cited art being different. But the
3 Examiner says, oh, but because the film thicknesses are the same, the prior
4 art then inherently discloses these properties of oxygen permeability, which
5 is the last element of Claim 1, as well as Claim 20, which has to do with
6 oxygen permeability at a certain temperature at less than 0.7 milliliter per
7 meter squared per day.

8 So the claim claims these properties in terms of oxygen permeability
9 through -- but doesn't claim specifically the name of the chemical
10 composition of the layers. But if you then look at the reference as well as
11 the invention, clearly the layers are made up with different chemical
12 compositions; therefore, what happens is that the Examiner says because the
13 thicknesses are the same, inherently there is similar oxygen permeability.
14 But it's not dependent on thickness. It's dependent on chemical composition
15 which hasn't been shown with more than mere possibility that the two are the
16 same.

17 So in other words, if you have three layers of papers, clearly you don't
18 have -- with identical thickness, clearly you don't have the same chemical
19 properties, physical properties, just because the thicknesses are the same. It
20 depends on the individual chemical layers as well as the overall composition
21 of the three layers.

22 So our first rebuttal to the rejection under inherency is that there hasn't
23 been shown that PA produces the same permeability as the claimed
24 properties because the outer layers are different.

25 JUDGE SMITH: Neither you or the Examiner identified the
26 properties of polyamide or PET.

1 MR. DAO: Not specifically, but qualitatively. I point that to

2 Hogstrom. Because what Hogstrom describes --

3 JUDGE SMITH: Before you go there --

4 MR. DAO: Okay.

5 JUDGE SMITH: -- let me do it this way.

6 MR. DAO: Okay.

7 JUDGE SMITH: Where in your specification do you describe the
8 properties of PET?

9 MR. DAO: It's only described in terms of the resultant emission
10 permeability, which is Figure 1, by having PET as the outer layer.

11 It then compares, for example, other layers, for example, PP as the
12 outer layer, and it shows that permeability, oxygen permeability is much
13 higher, and the reason is because PP retains moisture and therefore breaks
14 down the middle EVOH layer. So --

15 JUDGE SMITH: What you're showing in Figure 1 --

16 MR. DAO: Uh-huh.

17 JUDGE SMITH: -- are the layers identical with the exception of the
18 external layer being polypropylene versus the PET?

19 MR. DAO: That's correct.

20 JUDGE SMITH: Okay. Thank you.

21 MR. DAO: So if you then were to substitute PA, in short, it produces
22 a different property.

23 The second issue with the Independent Claims 1 and 18 under
24 anticipation, is the disclosure of a species range of 20 to 40 micrometer for
25 the outer layer. The Examiner points to Loretto citing 40 to 100, saying that
26 that is the same. The genus then, therefore, anticipates the species. And we

1 believe under case law, it's our understanding that a genus does not
2 anticipate, for the most part, the species, but the other way around, yes. So
3 it's our position then to rebut the second part of the anticipation, which is we
4 do not believe that the disclosed range of 40 to 100 anticipates the smaller
5 species range of 20 to 40.

6 Jumping now to the obviousness rejection. So this is a rejection of
7 Claim 18. Our position with respect to the obviousness rejection is that
8 there has not been a articulated reason with rational underpinning why the
9 Examiner took just the outer layer PET from Hogstrom and substitute that
10 with the PA layer from Lorette, the primary reference. And the reason being
11 are twofold.

12 First, when Hogstrom describes its prior art with PET, it's always in
13 combination with a second layer PA. And, in fact, Hogstrom says -- and if I
14 -- give me one second here to cite to a specific paragraph. This would be
15 column 3, lines 57 to 67. It says the inventive layer is surrounded by two
16 layers polyamide acting as a moisture absorber, will absorb water. The
17 EVOH layer will be protected from water because water will never have the
18 opportunity to pass the protective layer A and A-prime and C.

19 So in other words, as I summarized before, Hogstrom discloses like a
20 shield. It prevents -- its goal is to prevent moisture from coming in
21 altogether. So here the Examiner took just the outer layer PET, which is
22 always disclosed in combination with a second layer, and only took the outer
23 layer and substitute that for Lorette. There's not -- is shown anywhere that
24 that PET layer by itself is a good layer. In fact, in Figure 3 of the instant
25 application, in graph A-4 at the bottom, it shows that PET as an outer layer
26 by itself doesn't necessarily produce a good oxygen permeability, as you can

1 see from the graph in Figure 3 of the instant application. A-4 at the bottom,
2 it shows that PET doesn't necessarily produce an outer layer.

3 So in Hogstrom, even when the outer layer PET is eliminated, what it
4 desire is that the outer layer has to be PA, polyamide, which is the same as
5 Lorette. So there is no teaching whatsoever -- in fact, it teaches even away
6 from just taking PET as the outer layer. So our position then for the
7 obviousness rejection is there is no showing that one was substituted. It was
8 not discussed, described. And, in fact, just taking PET by itself, the data in
9 the prior art in the instant application doesn't support that position.

10 That concludes my presentation. If the Board has any question, I
11 would be happy to answer it.

12 JUDGE WARREN: Further questions? Judge Smith?

13 JUDGE SMITH: No further questions.

14 JUDGE WARREN: Judge Franklin?

15 JUDGE FRANKLIN: No, no more questions.

16 JUDGE WARREN: Thank you very much, counselor.

17 MR. DAO: Thank you. And if I could supplement the citations of
18 where I cite to some of these things, is there a number, a place where I could
19 submit the citations?

20 JUDGE WARREN: You can inquire of the Board. Send it through
21 the fax.

22 MR. DAO: Okay.

23 JUDGE WARREN: If you would?

24 MR. DAO: Okay. Will do.

25 JUDGE WARREN: Just call the Board number and they can give you
26 the fax number.

1 MR. DAO: Okay. Yeah. Thank you. Thank you, Your Honor.
2 (Whereupon, the proceedings, at 1:34 p.m., were concluded.)
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